



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/768,613	01/30/2004	Dwight M. Smith	27435.002	6773
7590 Constance Gall Rhebergen Bracewell & Patterson LLP P.O. Box 61389 Houston, TX 77208-1389				
			EXAMINER ZHENG, LOIS L	
			ART UNIT 1793	PAPER NUMBER
			MAIL DATE 05/14/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action**  
**Before the Filing of an Appeal Brief**

**Application No.**

10/768,613

**Applicant(s)**

SMITH, DWIGHT M.

**Examiner**

LOIS ZHENG

**Art Unit**

1793

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 07 May 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 14-20 and 35-50.  
Claim(s) withdrawn from consideration: 1-10.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☒ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

/Roy King/  
Supervisory Patent Examiner, Art Unit 1793

Continuation of 3. NOTE: New amendment to claim 14 is inconsistent with finally rejected claim 14. Applicant removed limitation that "the target fluid comprises a hydrophilic fluid". However, finally rejected claim 14 filed 24 November 2008 does not recite such a limitation. Finally rejected claim 14 recites that "the target fluid comprises a hydrocarbon".

Continuation of 11. does NOT place the application in condition for allowance because: The declaration filed 7 May 12, 2009 is not sufficient to overcome prima facie case of obviousness. In the declaration, applicant argues that the claimed invention does not produce foam. The examiner finds applicant's argument to be moot because foaming of the solution is outside of the claim scope. Applicant further discussed that his attempt to create a foaming solution using 100% hydrocarbon in accordance with Chumat failed to produce a foaming solution. Applicant's argument is not convincing because Chumat also teaches a target fluid that is a mixture of water and a hydrocarbon solvent (col. 10 lines 21-33), which also reads on the claimed target fluid. Applicant further argues that the foam would be detrimental to engine operation if introduced into a running engine. Applicant's argument is merely a conclusive statement absent persuasive evidence demonstrating the detrimental effects of the foaming solution of Chumat to engine operation. Applicant's further argument regarding the pH difference between Chumat and the instant invention is not convincing because the higher limit of about 5.5 as taught by Chumat is very close to the lower limit of claimed pH of about 6.0. Therefore, one of ordinary skill in the art would have expected the effect of pH at about 5.5 as taught by Chumat to be very similar to the claimed pH of about 6.0.

In the remarks, applicant additionally argues that Chumat and Hudson are in unrelated fields because Hudson does not teach a protective conversion coating layer. The examiner does not find applicant's argument persuasive because Hudson teaches forming a phosphate containing layer on the steel surface (col. 2 lines 45-57) which implies a phosphate conversion coating. In addition, Hudson's patent is also classified in the conversion coating subclasses of class 148. It is examiner's position that one of ordinary skill in the art would have realized that Hudson is directed to phosphate conversion coatings when reviewing Hudson. Applicant further argues that Hudson and Chumat are not combinable because the pH of Hudson is different from the pH of Chumat. The examiner does not find applicant's argument persuasive because Hudson is not introduced to the rejection ground for its teaching of pH. Hudson is incorporated into the rejection ground for its disclosure that shows mono- and di-basic ammonium phosphate and potassium phosphates are functionally equivalent compounds.